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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,362	08/01/2001	Tommi Koistinen	975.354USW1	4266

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EXAMINER

NGUYEN, VAN KIM T

ART UNIT PAPER NUMBER

2151

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,362

Applicant(s)

KOISTINEN, TOMMI

Examiner

Van Kim T. Nguyen

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-64, 67-84, and 86-91 is/are rejected.
- 7) ☒ Claim(s) 65,66 and 85 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to communications filed on April 14, 2006.

Claims 59-91 are pending in the case.

Response to Arguments

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Objections

3. Claim 64 is objected to because of the following informalities:

Claims 64-65 recite the limitation “---, wherein further comprising” in lines 1-2. It should be “---, wherein further comprising:”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 59-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 59 recites the limitation "said first communication device (1)" in line 4. There is insufficient antecedent basis for this limitation in the claim since "a first communication device (1)" was not disclosed previously.

Claim 62 recites the limitation "said network control device" in line 4. There is insufficient antecedent basis for this limitation in the claim since "a network control device" was not disclosed previously.

Claim 62 recites the limitation "as second communication device (7)l on line 3 and "said tone signal (TS)l" on line 6. It is not clear what applicant is disclosing.

Claim 63 recites the limitation "said second interface established device (51; 51)" in line 6-7. There is insufficient antecedent basis for this limitation in the claim since "a second interface established device (51; 51)" was not disclosed previously.

Claim 63 also recites the limitation "said second interface establishing device (51)" in line 3 and "said second interface establishing device (51; 52)" in line 11. It is not clear whether the disclosed limitations are the same.

Claim 63 also recites the limitation "a second communication device (7) ---", while claim 65 recites "a second communication device (72) ---". It is not clear whether the disclosed limitations are the same.

Claim 63 also recites the limitation "said tone signal (TS) ---", while claim 67 recites the limitation "said control signal (TS) ---". It is not clear whether the disclosed limitations are the same.

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Claim 68 recites the limitation “first communication means (1)” in line 2. There is insufficient antecedent basis for this limitation in the claim since “a first communication means(1)” was not disclosed previously.

Claim 70 recites the limitation “said first communication device (1) ---“, while claim 71 recites the limitation “--- said first communication device 91 ---“. It is not clear whether the disclosed limitations are the same.

Claims 72-73 recite the limitation “--- said second communication device (7; 72). There is insufficient antecedent basis for this limitation in the claims since “a second communication device (7; 72)” was not disclosed previously.

Claims 74-76 recite the limitation “--- said first interface establishing means ---“. There is insufficient antecedent basis for this limitation in the claim since “a first interface establishing means” was not disclosed previously. It is not clear whether this limitation is the same with “a first interface device” which was disclosed earlier.

Claim 59 recites the limitation “--- a first interface establishing device (30; 31; 32) ---” in line 2, while claims 76-77 recites the limitation “---said first interface establishing means (60; 61; 62---“ in lines 3-4. It is not clear whether the disclosed limitations are the same.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 59-74, 76, and 78-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Naudus (US 6,259,691).

Regarding claim 59, as shown in Figures 1-3, Naudus discloses:

a first interface establishing device (60) connected between the first network control device (40) and a transmitting network (20); wherein

the first communication device (10) and the first network control device (40) are connected such that a use signal (Audio) and a control signal (DTMF) are sent separately to the first network control device (see Figure 3);

the first network control device (40) and the first interface establishing device (60) are connected such that the use signal (Audio) and the control signal (DTMF) are sent separately to the first interface establishing device (see Figure 3);

the first interface establishing device (60) is adapted to send the control signal (DTMF) over the transmitting network (20); and

a tone generation means is provided on the far-end side of the network (80) for receiving the control signal (DTMF) after transmission through the transmitting network (20) and for generating the tone signal in response to the control signal (col. 12: line 24 – col. 13: line 33).

Regarding claim 60, Naudus also discloses the first interface establishing device (60) comprises a compressing means for compressing the use signal, the compressed signal being sent over the transmitting network (col. 12: lines 44-51).

Regarding claim 61, Naudus also discloses a second interface establishing device (60) connecting to the transmitting network (20) ; wherein the second interface establishing device

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(60) comprises a decompressing means for decompressing the use signal received via the transmitting network (20), and the tone generation means (col. 12: line 62 – col. 13: line 10).

Regarding claim 62, Naudus also discloses a second communication device (12) and a second network control device (80), wherein the second interface establishing device (60) is adapted to combine the use signal and the tone signal; and the second network control device (80) is adapted to receive the combined signal and to send it to the second communication device 12 (See Figure 3).

Regarding claim 63, Naudus also discloses a second interface establishing device (60) connected to the transmitting network (20); and a second network control device (80); wherein the second interface establishing device (60) comprises a decompressing means for decompressing the use signal (Audio) received via the transmitting network (20); and a control transfer means receiving the control signal and sending the control signal to the second network control device (80), wherein the second interface establishing device (60) is adapted to send the use signal (Audio) to the second network control device (see Figure 3; col. 8: line 23 – col. 13: line 10).

Regarding claim 64, as shown in Figures 1-8, Naudus discloses a second communication device (12); wherein the second network control device (80) comprises the tone generation means; and the second network control device (80) is adapted to combine the use signal (Audio)

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and the tone signal (DTMF) and to send the combined signal to the second communication device 12 (col. 8: line 23 – col. 13: line 10).

Regarding claim 67, Naudus also discloses the tone signal generated in response to the control signal is a DTMF signal (see Figure 3; col. 12: line 62 – col. 13: line 10).

Regarding claim 67, Naudus also discloses the first communication device (10) is adapted to generate the control signal (DTMF) in response to an operation of a key (col. 8: line 23 – col. 13: line 10).

Regarding claim 69, Naudus also discloses the transmitting network (20) is an IP based network (see Figure 3).

Regarding claim 70, Naudus also discloses the first communication device (10) is a mobile phone (e.g., any device capable of communicating audio signals over the telephone network; col. 6: lines 54-67).

Regarding claim 71, Naudus also discloses the first communication device (10) is a fixed phone (see Figure 3; col. 6: lines 54-67).

Regarding claim 72, Naudus also discloses the second communication device (12) is a mobile phone (e.g., any device capable of communicating audio signals over the telephone network; col. 6: lines 54-67).

Regarding claim 73, Naudus also discloses the second communication device (12) is a fixed phone (see Figure 3).

Regarding claims 74 and 76, Naudus also discloses the first network control device (40) and the first interface establishing means (60); and the second network control device (80) and the first interface establishing means (60), are constructed as one unit (see Figure 3).

Regarding claim 78, Naudus also discloses a network communication device (10) connectable directory to the transmitting network (20) such that the control signal (Audio) and the use signal (DTMF) is transmitted from the first interface establishing device (60) to the network communication device (see Figure 3).

Regarding claim 79, Naudus also discloses the transmitting network (20) is an IP based network and the network communication device (10) is an IP phone (see Figure 3; col. 6: lines 54-67).

Regarding claims 80-85, claim 80 is method claims that have substantially all the limitations of the respective apparatus claim 59. A method claim is obvious in view of an

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apparatus claim and vice versa if they each contain substantially the same elements. Thus claim 80 is reject under the same basis as claim 59.

Similarly, dependent claims 81-85 are rejected under the same basis as claims 60-79.

Regarding claim 86, Naudus also discloses an interface establishing device (60) for providing a connection over a transmitting network (20), wherein a communication device (10) is connectable to the interface establishing device (60), the interface establishing device comprising:

means for receiving a use signal (Audio) and a control signal (DTMF) separately from the communication device (10), wherein the control signal (Audio) is to be used to generate a tone signal at the far-end side of the transmitting network (80), (see Figure 3; col. 12: line 62 – col. 13: line 10); and

means for sending the control signal (DTMT) and the use signal (Audio) separately via the transmitting network 20 (see Figure 3; col. 8: line 23 – col. 13: line 10).

Regarding claim 87, Naudus also discloses a compressing means for compressing the use signal, the compressed signal (Audio) being sent over the transmitting network (20); (see Figure 3; col. 8: line 23 – col. 13: line 10).

Regarding claim 88, Naudus also discloses an interface establishing device (60) for providing a connection over a transmitting network (20), wherein a communication device (10) is connectable to the interface establishing device (60), the interface establishing device (60) comprising:

means for receiving a use signal (Audio) and a control signal (DTMF) separately via the transmitting network (see Figure 3; col. 12: line 62 – col. 13: line 10);

means for generating the tone signal in response to the control signal (see Figure 3; col. 8: line 23 – col. 13: line 10); and

means for combining the tone signal (DTMF) and the use signal (Audio) and sending the combined signal to the communication device 12 (see Figure 3; col. 8: line 23 – col. 13: line 10).

Regarding claim 89, Naudus also discloses the use signal (Audio) is sent in compressed form via the transmitting network (20), the interface establishing device (60) further comprising:

a decompressing means for decompressing the use signal received via the transmitting network (see Figure 3; col. 12: line 62 – col. 13: line 10).

Regarding claim 90, Naudus also discloses an interface establishing device (60) for providing a connection over a transmitting network (20), wherein a communication device (10, 12) is connectable to the interface establishing device (60), the interface establishing device (60) comprising:

means for receiving a use signal (Audio) and a control signal (DTMF) separately via the transmitting network (see Figures 3); and

means for sending the use signal (Audio) and the control signal (DTMF) separately to the communication device (12), wherein the control signal (Audio) is to be used to generate a tone signal (see Figure 3; col. 8: line 23 – col. 13: line 10).

Regarding claim 91, Naudus also discloses the use signal (Audio) is sent in compressed form via the transmitting network (20), the interface establishing device (60) further comprising: a decompressing means for decompressing the use signal received via the transmitting network (see Figure 3; col. 12: line 62 – col. 13: line 10).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. ***Claims 75 and 77*** are rejected under 35 U.S.C. 103(a) as being unpatentable over the Naudus (US 6,259,691) as applied to claim 59 above.

Naudus disclose substantially all the claimed limitations, except Naudus does not explicitly disclose the first network control device and the first interface establishing devices are constructed as separate units. However, since it is well known in the art the arrangement of device and interface device is a design choice, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the first network control device and the first interface establishing device can be constructed as separate units in order to meet space or cost requirements.

Allowable Subject Matter

Claims 65-66 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 85 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Van Kim T. Nguyen whose telephone number is 571-272-3073. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Van Kim T. Nguyen
Examiner
Art Unit 2151

vkn

Khanh Dinh
Primary Examiner